

## **REMARKS**

### **I. Status of the Claims**

Claims 28-64 are pending in this application. Claims 32, 54, and 62 are amended to remove formula (F2) recited therein. Claims 31, 53, and 61 are amended to remove the recitation of azomethine dyes. Claims 28, 47, 55, 63, and 64 are amended to recite that the at least one fluorescent dye is not the dye of formula (F2) recited in previously presented claims 32, 54, and 62. Applicants submit that this proviso is fully supported as described below.

Specifically, Applicants believe that the proviso added to the claims is fully supported by the specification as filed. Applicants assert that they are simply claiming less than the full scope of the disclosure – a legitimate procedure for inventors entitled to decide the bounds of protection they seek. *See, e.g., In re Johnson*, 558 F.2d 1008 (C.C.P.A. 1977). The court in *Johnson* found that a "broad and complete generic disclosure, coupled with extensive examples fully supportive of the limited genus now claimed" supported the exclusion of specific compounds. 558 F.2d at 1018. In *Johnson*, a broad class of precursor compounds was recited including 26 specific examples. An added proviso excluded certain compounds to provide a limited genus, where 14 examples fell within the scope of the limited genus. The court in *Johnson* held that the written description supported the broader genus, and "having described the whole, necessarily described the part remaining." *Id.* at 1019.

*Ex parte Grasselli*, 231 USPQ 393, 394 (Bd. Pat. App. 1983) is often cited by the USPTO in response to an amendment limiting the scope of a claim in view of prior art. In *Grasselli*, the claim at issue related to a process for the ammoxidation of propane or

isobutane comprising using a catalyst described in a certain formula. In response to an Office Action, the applicant amended a claim to recite that the catalyst was free of uranium and the combination of vanadium and phosphorus. The claimed formula, however, did not originally cover uranium. Thus, the applicant sought to exclude uranium from the catalyst, but uranium was not a species falling within the genus of the recited catalytic formula. The Board held that there was no written description for the negative limitation.

The *Grasselli* facts sharply contrast with the present facts. In *Grasselli*, uranium was never covered by the original genus. In the present case, Applicants seek nothing more than to proviso out a particular species of fluorescent dye (the dye of formula (F2)), which falls within the original genus of compounds defined. Thus, *Grasselli* is inapplicable to the present application.

Moreover, adequate written description, particularly with respect to provisos, does not require literal support for the claimed invention. *In re Wertheim*, 191 USPQ 90, 98 (CCPA 1976). Applicants assert that the present facts fall directly within the rationale of *Wertheim*, which held that to rule that the entire genus is not patentable because the applicant erroneously thought he was the first to invent the genus of compounds would exalt form over substance. *Id.* at 97. The present situation, like that in *Wertheim* (and in contrast to the situation in *Grasselli*), does not involve a new concept. Rather, the present situation involves a member of the originally claimed genus that is simply being excised. *Wertheim* approved that approach, and the Office has no reason to treat Applicants any differently.

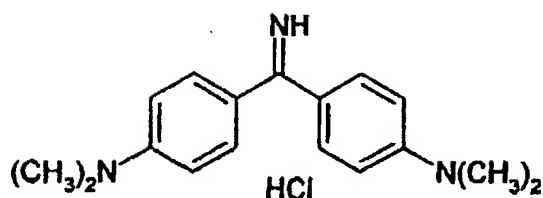
As established above, Applicants have the right to claim less than the full scope of their disclosure, and thus can exclude the dye of formula (F2). As such, Applicants assert that the proposed proviso has sufficient support in the specification. Accordingly, these amendments do not introduce new matter and require no further search by the Examiner.

## II. Rejections Under 35 U.S.C. § 102 and 103

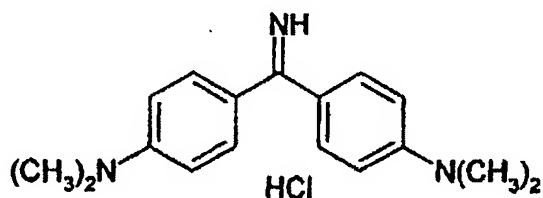
Claims 28-64 are rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent Application Publication No. 2001/0054206 to Matsunaga et al. ("Matsunaga") in view of U.S. Patent No. 5,961,667 to Doehling et al. ("Doehling"). Applicants assert that this rejection is obviated in view of the claims as amended.

To prove a *prima facie* case of obviousness, the Office must show that the cited references would have provided to the skilled artisan some suggestion or motivation to combine or modify their teachings in an effort to achieve all of the limitations of the claimed invention, with a reasonable expectation of success. See MPEP § 2143. For at least the reasons discussed below, none of the references relied upon by the Office contains any such suggestion or motivation or the requisite reasonable expectation of success.

The present claims, for example, independent claim 28, as amended, recite a composition for dyeing hair comprising at least one fluorescent dye, wherein that dye is not



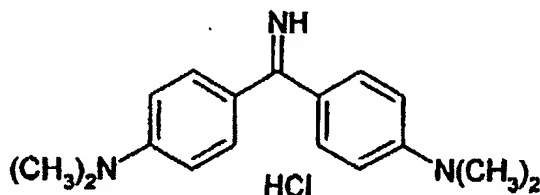
In contrast, *Matsunaga* describes hair dye compositions containing an azomethine dye of the above formula. See abstract. *Matsunaga* does not disclose or suggest hair dye compositions comprising fluorescent dyes falling within the scope of the claims as presently amended. Thus, *Matsunaga* fails to teach or suggest a composition comprising at least one fluorescent dye with at least one cationic polymer wherein the at least one fluorescent dye is not



To the contrary, *Matsunaga* does not suggest or provide any guidance to one skilled in the art to use any fluorescent dyes other than those listed in the abstract of the reference. Accordingly, as applied to the claims as amended, *Matsunaga* does not teach or suggest each and every element of the pending claims, and thus, *Matsunaga* alone cannot form a proper basis for a *prima facie* case of obviousness.

*Matsunaga* is the sole reference relied upon by the Examiner which allegedly discloses fluorescent dyes in hair dye compositions. The secondary reference, *Doehling*, does not disclose or suggest hair dye compositions comprising fluorescent dyes. Thus, the combination of these references also necessarily fails to teach or

suggest a composition comprising at least one fluorescent dye with at least one cationic polymer wherein the at least one fluorescent dye is not chosen from



Accordingly, in view of the above arguments and claim amendments, Applicants asserts that the presently pending claims are patentably distinct over the cited art and respectfully request that the Examiner withdraw all rejections and allow the claims.

### CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 

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